REMARKS

Examiner has deemed the drawings submitted with the application to be informal but suitable for publication and examination. Upon explanation of the informality and upon notice of allowance, Applicant will provide corrected formal drawings.

Examiner has rejected claims 1-8 under 35 U.S.C.§101, believing the those claims to be directed to non-statutory subject matter. Specifically, Examiner believes the claim language to be merely non-functional descriptive material disembodied from technological arts.

35 U.S.C. §101 provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Claims 1-8, by their structure, fall within the well known pattern for process claims. The examination, then, should be directed to whether the process is new and useful - particularly whether it is useful and not merely an abstract idea, law of nature, or natural phenomenon. *See* Diamond v. Diehr, 450 U.S. 175, 209 USPQ 1 (1980). The current test is whether a useful, concrete, and tangible result is produced in respect to computer-implemented inventions. *See* In re Alappat, 31 USPQ 2d 1545 (Fed. Cir. 1994), State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ 2d 1596 (Fed. Cir. 1998). Examiner has referred to a "technical arts" classification, which Applicant assumes means the constitutional "useful arts" (*See* In re Waldbaum, 173 USPQ 430 (CCPA 1971) and not a new category like "technical character" currently being used in the EPO and other foreign patent offices. In approaching the current useful test, "...it is now clear that computer-based programming constitutes patentable subject matter so long as the basic requirements of §101 are met." AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1360, 50 USPQ 2d 1447, ___ (Fed. Cir. 1999). In citing State Street, the CAFC makes clear "...that 'unpatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not "useful"... to be patentable an algorithm must be applied in a "useful" way.' ... In [State Street], the claimed data processing system for implementing a financial management structure satisfied the §101

inquiry because it constituted a 'practical application of a mathematical algorithm, ... [by] producing a "useful, concrete, and tangible result."'" AT&T, 172 F.3d 1352, 1357, 50 USPQ 2d 1447, ___ (Fed. Cir. 1999). According to the CAFC, Alappat focuses the §101 inquiry to "an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a 'law of nature' or an 'abstract idea,' or if the mathematical concept has been reduced to some practical application rendering it 'useful.' ... In Alappat, we held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display." Id.

In Applicant's invention, as now claimed, there is a clear reference to a specific machine, a "server", that in performing the required steps of independent claim 1, produces at least one useful, concrete, and tangible result: including advertisement with content at the server upon certain two matches.

Examiner has rejected independent claims 1 and 9, and dependent claims 2-8 and 10-16 under 35 U.S.C.§ 103 (a) as being unpatentable over USP 5,664,948 to Dimitriadis et. al ("Dimitriadis"). Dimitriadis discloses method and apparatus for the delivery of preloaded advertising data over broadcast facilities. The problem being addressed by Dimitriadis is that of making the delivery of advertising information to listeners more efficient. (See col. 1, lines 61-62). Dimitriadis broadcasts data (which can include advertising data) to a receiving device where it is collected and stored within the receiving device. This receiving device (which, in the preferred embodiment, is a combination of a car radio and paging device) can present the advertising data multiple times even though the data was only broadcast by the radio station once, thereby incurring less expense for the advertiser. (See col. 2, lines 3-21). Once the data is stored in the receiving device, certain conditions will cause the stored data to be presented. Dimitriadis lists these conditions as: being near a given geographic point of interest, time of day, power-up of the receiving device, or upon command. (See col. 4, lines 32-39). The receiving device maintains the data in a record structure, which includes a unique index (400a) that is designated and later used by the advertiser to trigger presentation of advertising and includes a condition list (400b), including a time of presentation, for

triggering presentation. (See col. 5, lines 52-65). Targeted advertising data, i.e., advertising that is targeted to a specific group of audiences, can be loaded into one group of receiving devices while entirely different advertising data can be loaded into the receiving devices of a different audience group. A group of listeners is identified by the advertiser, who "develops" a profile for the listeners of the receiving devices "as is typically done in advertising strategies" (col. 9, lines 51-52). "[I]ssuance of the PRESENT command 500c relative to such common index value causes distinct advertising presentation for different groups of listeners. As may be appreciated, the radio signal transmission time associated with issuing the PRESENT command 500c is quite small compared to similar advertisement broadcast time required to deliver by conventional means the same advertisement presentation, i.e., broadcast time required to present the advertisement to listeners currently tuned to the broadcast facility." (Col. 9, line 61 through col. 10, line 6). Thus, the advertiser directs the receiving device to recall and present a targeted advertisement to users profiled by the advertiser at a time selected by the advertiser.

This is not the invention claimed by Applicant. Applicant's claim 1 requires that the server "includ[e] said advertisement with the content..." Since Dimitriadis' broadcast facility only broadcasts the PRESENT command with the radio broadcast content (specifically, to be more efficient), Dimitriadis does not include advertisement with the content. Dimitriadis advertising data is collected and stored by the receiving device for later delivery to the listener. Moreover, Applicant's claim 1 requires that the advertisement be included with the content when both "said current time matches said time significance and said subscriber advertising profile matches said attribute." While Dimitriadis considers time of day or a paging signal command for a selected advertisement among the conditions causing presentation of stored advertising information (see col. 4, lines 32-39), Dimitriadis does not teach or suggest the requirement of both conditions. In fact, Dimitriadis cannot include both since the decision to present selected advertisement is made by the advertiser while the decision regarding the determination of listener current time is made by the receiving device.

Applicant's claim 1, as amended, also requires that it is the user who defines the profile and it is this profile that is recalled and compared to the advertisement attribute.

This is a distinct difference from Dimitriadis, which develops its profile without specific user input regarding the user's desires.

Independent claim 9 shares the foregoing major distinctions from Dimitriadis and also requires that the clock be located at the server, not at the receiving device.
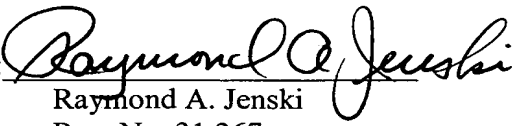
Dependent claims 6 and 13 require that the content and included advertisement be delivered in accordance with a request of the server by the subscriber. Dimitriadis does not allow the subscriber to request delivery of content and included advertisement from the broadcast station (the "...broadcast system 20 is a one-way communication..." col. 5, line 57).

Dependent claims 7 and 14 require that the request for delivery be generated from a predetermined schedule of the subscriber. Since Dimitriadis does not accept a profile from the listeners, Dimitriadis does not teach or suggest the use of a subscriber schedule to determine the delivery time.

Despite Examiner's assertions that one of ordinary skill would create Applicant's claimed invention from Dimitriadis' delivering advertising information to a receiving device...by reference to a time schedule...by developing a profile for the users, Applicant has described distinctions, above, that would not be apparent to one of ordinary skill without more. Therefore, in view of the foregoing Amendment, Applicants believe the present Application, as amended, to be in a condition suitable for allowance. Examiner is respectfully urged to withdraw the rejections upon reconsideration of the Application as amended and pass the amended Application to allowance.

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ATTACHMENT 1

1. (Currently Amended) A method of delivering content and time significant advertising from a server to a subscriber comprising the steps of:

      accepting a subscriber advertising profile;

      storing said subscriber advertising profile at the server;

      determining an attribute of and a time significance for an advertisement;

      recalling at the server said a previously stored subscriber advertising profile;

      comparing said subscriber advertising profile to said attribute;

      determining a current time of the subscriber;

      comparing said current time to said time significance; and

      including said advertisement with the content at the server when said current time matches said time significance and said subscriber advertising profile matches said attribute.

2. (Original) A method in accordance with the method of claim 1 wherein said determining a current time further comprises the steps of:

      recalling a postal code associated with the subscriber; and

      mapping a local time zone correction established by said postal code to a time standard.

3. (Original) A method in accordance with the method of claim 1 wherein said determining an attribute further comprises the step of recalling at least one previously stored attribute associated with said advertisement.

4. (Original) A method in accordance with the method of claim 1 wherein said determining a time significance further comprises the step of recalling a previously stored time period associated with said advertisement and having time relevance to said advertisement.

5. (Original) A method in accordance with the method of claim 4 wherein said comparing said current time to said time significance further comprises the step of determining whether said current time is within said time period, thereby matching said time significance.

6. (Currently Amended) A method in accordance with the method of claim 1 further comprising the step of delivering the content and said included advertisement from the server to the user in accordance with a request of the subscriber.

7. (Original) A method in accordance with the method of claim 6 further comprising the step of obtaining a request for delivery generated by a predetermined schedule of the subscriber.

8. (Original) A method in accordance with the method of claim 7 wherein said step of obtaining a request for delivery further comprises the step of generating said request for delivery from said predetermined schedule.

9. (Currently Amended) A service provider server that delivers content and time significant advertising to a subscriber from a network, comprising:

a memory that stores a subscriber advertising profile provided by the subscriber;

at least one network interface that accesses the network to obtain an advertisement, an attribute of said advertisement, and a time significance for said advertisement;

a clock at the server that generates a current time associated with the subscriber; and

a processor coupled to said memory, said at least one network interface, and said clock and adapted to compare said subscriber advertising profile to said attribute, to compare said current time to said time significance, and to include said advertisement with the content when said current time matches said time significance and when said subscriber advertising profile matches said attribute.

10. (Original) A service provider server in accordance with claim 9 further comprising a postal code stored in said memory and associated with the subscriber, and wherein said clock is adapted to map a local time zone correction established by said postal code to a time standard to generate said current time.

11. (Original) A service provider server in accordance with claim 9 wherein said time significance further comprises a time period associated with said advertisement and having time relevance to said advertisement.

12. (Original) A service provider server in accordance with claim 11 wherein said processor is further adapted to compare said current time to said time period to determine whether said current time is within said time period, thereby matching said time significance.

13. (Original) A service provider server in accordance with claim 9 wherein said processor is further adapted to deliver the content and said included advertisement to the user via a one of said at least one network interface in accordance with a delivery request of the subscriber.

14. (Original) A service provider server in accordance with claim 13 wherein said processor is further adapted to obtain a request for delivery generated by a predetermined schedule of the subscriber.

15. (Original) A service provider server in accordance with claim14 wherein said processor is further adapted to generate said request for delivery from said predetermined schedule.

16 (Original) A service provider server in accordance with claim 15 wherein said memory is further adapted to store said predetermined schedule.